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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,684	01/14/2004	Michael Patrick Galligan	4882	4080

48226 7590 02/24/2006

ENGELHARD CORPORATION
101 WOOD AVENUE
ISELIN, NJ 08830

EXAMINER

HAILEY, PATRICIA L

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/757,684	GALLIGAN ET AL.	
	Examiner	Art Unit	
	Patricia L. Hailey	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 11-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 10 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicants' remarks and amendments, filed on November 30, 2005, have been carefully considered. No claims have been canceled or added; claims 1-23 remain pending in this application.

Election/Restrictions

1. Claims 11-23 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected method for preparing a coated metal substrate, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the previous Office Action, which was mailed on June 27, 2005.

The traversal is on the grounds that there is no undue burden to examine both groups of claims, as the groups of claims are directed to a coated substrate and to a "method of forming such coated substrates".

Applicants' arguments traversing the restriction requirement are not persuasive, because the claimed method and the claimed product have been shown to be distinct, as the product as claimed can be prepared by another and materially different process, such as by chemical or physical vapor deposition, or by plasma deposition.

Additionally, the claimed method and the claimed product, based on their different classification, are of divergent subject matter, and have a separate status in the art.

For these reasons, the restriction is deemed proper and is therefore FINAL.

However, should the product claims be found allowable, the Examiner will consider rejoining the non-elected method claims, should these claims contain all of the limitations of the allowable product claims.

Claims 1-10 remain under consideration by the Examiner.

Withdrawn Rejections

The 112(2) rejection of claim 4, stated in the previous Office Action, has been withdrawn in view of Applicants' amendment to this claim.

The 102(b) rejection of claims 1-5 as being anticipated by Blanchard et al. (U. S. Patent No. 4,492,769), stated in the previous Office Action, has been withdrawn in view of Applicants' persuasive arguments traversing this rejection.

The 102(b) rejection of claims 1-5 and 9 as being anticipated by Lachman et al. (U. S. Patent No. 5,244,852), stated in the previous Office Action, has been withdrawn in view of Applicants' persuasive arguments traversing this rejection.

The 103(a) rejection of claims 6-8 and 10 as being unpatentable over Blanchard et al. or Lachman et al., as stated in the previous Office Action, has been withdrawn in view of Applicants' arguments traversing this rejection.

New Ground of Rejection

The following New Ground of Rejection is being made in view of the newly discovered reference to WO 03/050397 and U. S. Patent No. 6,725,656.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. *Claims 1-7, 9, and 10 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 03/050397.*

The WO document discloses an exhaust manifold (Figures 2 and 3) comprising an inner layer (22), an insulation layer (24), and an outer structural layer (28). There may also be, disposed between the outer layer and the insulation layer, a strain isolation layer (26).

The inner layer is composed of ceramic fibers and non-fibrous ceramic filler material. The ceramic fibers may be aluminosilicate fibers or alumina fibers, and the ceramic filler may be alumina or mullite (aluminosilicate). See paragraphs [0029] and [0030] of the WO document, which also discloses that the ceramic fibers can be short (having a length of about 10-1000 micrometers), long, or a mixture thereof (this disclosure is considered to read upon the particle size disclosed in Applicants' **claims 6 and 7**, as the reference teaches alumina fibers).

The insulation layer is also a ceramic layer, and is composed of ceramic fibers and non-fibrous ceramic filler material similarly to the aforementioned inner layer. See paragraph [0032] of the WO document.

The outer layer is preferably made from metal; examples include cast ferrous metal or metal alloy such as steel. See paragraph [0037] of the WO document (considered to read upon the limitation “metal substrate” in **claims 1, 4, and 5**).

A catalyst may be added to the inner layer; the catalyst can be any suitable catalyst material that is conventional or known in the art. See paragraphs [0047] of the WO document (considered to read upon **claims 2 and 3**), as well as paragraphs [0048]-[0050] and [0053], which discloses a catalyst body in addition to that also provided in the inner layer, in which begins the “pollutant and noxious gas abatement process in the manifold...” (considered to read upon the limitation “exhaust gas silencer” in **claims 9 and 10**).

The WO document is silent as to the application of the alumina “while the coating is still wet on the substrate”. However, the limitation recited in claim 1, “applied to the coating while the coating is still wet on the substrate” is considered a process limitation and, since the claimed invention is directed to a coated substrate, this limitation is not given patentable weight.

In view of these teachings, the WO document anticipates claims 1-7, 9, and 10.

Allowable Subject Matter

4. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter:

While the WO document discloses an exemplary percentage ranges for the ceramic filler material and ceramic fibers (paragraph [0030], bridging pages 7 and 8 of the WO document), the reference is silent with respect to the amount of silica particles in terms of g/in², as recited in claim 8.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

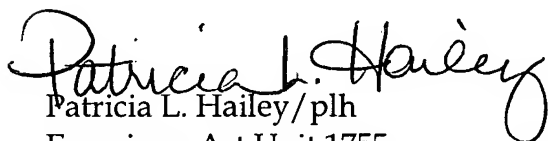
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

Art Unit: 1755

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patricia L. Hailey/plh
Examiner, Art Unit 1755
February 21, 2006



ANTHONY J. GREEN
PRIMARY EXAMINER